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Remarks

This communication is responsive to the Final Office Action of July 19, 2006.
Reexamination and reconsideration of claims 1-21 is respectfully requested.

Summary of The Final Office Action

Claims 1-8, 10-12 and 14-19 were rejected under 35 U.S.C. §102(b) as being anticipated by newly cited U.S. Patent No. 5,042,791 (Stemmle).

Claim 21 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,042,791 (Stemmle) or in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,042,791 (Stemmle) in view of U.S. Patent No. 5,724,642 (Cala).

Claims 9, 13 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,042,791 (Stemmle) as applied to claims 6, 10 and 16 above, and further in view of U.S. Patent No. 6,308,948 (Azumi).

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The Claims Patentably Distinguish Over the References

Independent Claim 1

Claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by newly cited Stemmler - U.S. Patent No. 5,042,791 (Stemmler).

Claim 1 recites a media feeder ... configured to input print media into the duplex media path of the image forming device, and the media feeder being positioned to not be part of the duplex media path. The Office Action on page 2 identifies a duplex media path in Stemmler as from rollers 39 to 42, then the paper passes through inverter 40 and the paper is outputted into rollers 88 (see figure 1 and 8). The rejection cites figure 8 where paper tray 83 can input paper into rollers 88 (labeled in figure 1, but not labeled in figure 8) to teach "to input print media into the duplex media path".

Applicant respectfully submits that Stemmler fails to teach or suggest the claimed media feeder. Stemmler teaches that the duplex path is formed by the inverter 40 and the output of inverter 40 leads to rollers 88. Stemmler's paper tray 83 (in figure 8) inputs paper into rollers 88 and thus the paper is not inputted to the path of the inverter 40. Therefore, paper tray 83 does not input paper into the duplex paper path.

The specification of Stemmler provides no additional teaching or suggestion relating to the paper tray 83. Only one sentence refers to the paper tray 83, which states "Also illustrated in FIG. 8 is a further paper tray 83 and a segmented feed roll 84 which provides an alternative print substrate." (Column 9, line 68 to column 10, line 2). Therefore, Stemmler fails to teach the claimed media feeder.

For these reasons, claim 1 is not anticipated by Stemmler, Stemmler fails to support the rejection, and the rejection should be withdrawn. Claim 1 thus patentably distinguishes over the references of record and should be allowed. Accordingly, dependent claims 2-9 also patentably distinguish over the references of record and are in condition for allowance.

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Independent Claim 10

Claim 10 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,042,791 (Stemmle).

Claim 10 recites "a media input unit configured for attachment to one side of the image forming device to input non-imaged media into the return media path of the image forming device." The Office Action on page 4 relies on the same paper tray 83 of Stemmle as cited under claim 1. As explained above, paper tray 83 inputs paper into rollers 88, which are downstream from the duplex path formed by the inverter 40. As recognized by the Examiner, the paper tray 83 is described to: "input print media at the outlet of 40 in Fig. 8" (Office Action, page 4, paragraph 5). Thus, paper tray 83 fails to meet the claimed limitation of a media input unit to input non-imaged media into the return media path. Accordingly, claim 10 is not anticipated by Stemmle.

Furthermore, claim 10 recites "where the media input unit is positioned where the return media path does not return the imaged media across the media input unit during duplex printing." As seen in Stemmle figure 8, the inverter 40 forms the duplex path that travels across the paper tray 83. Thus, the claimed limitation is not anticipated.

For this reason, claim 10 is not anticipated or made obvious, and Stemmle fails to support a proper §102 rejection. Claim 10 thus patentably distinguishes over Stemmle and is in condition for allowance. Accordingly, dependent claims 11 – 15 also patentably distinguish over the references of record and are in condition for allowance.

Independent Claim 16

Claim 16 was rejected under 35 U.S.C. §102(b) as being anticipated by newly cited U.S. Patent No. 5,042,791 (Stemmle).

Claim 16 recites an image forming apparatus comprising a media storage unit, a primary media path, and a duplex media path where the duplex media path is configured to receive non-

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imaged print media from the media storage unit and to input the non-imaged print media to the primary media path for imaging.

The Office Action on page 6 cites Stemmler figure 8 and paper tray 83 as teaching the claimed media storage unit. However as previously explained, paper tray 83 does not input media into the duplex path of the inverter 40. Rather, media is inputted downstream of the duplex path into rollers 88. Thus, the duplex path of Stemmler fails to teach the claimed duplex media path configured to receive non-imaged print media from the media storage unit.

Therefore, Stemmler fails to teach each and every limitation of claim 16 and fails to establish a proper §102 rejection. The rejection should be withdrawn and claim 16 should be allowed. Accordingly, dependent claims 17 – 21 also patentably distinguish over the references of record and are in condition for allowance.

Dependent Claim 21

Claim 21 was rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,042,791 (Stemmler) or in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 5,042,791 (Stemmler) in view of U.S. Patent No. 5,724,642 (Cala).

Claim 21 depends from independent claim 16. Since Stemmler fails to teach a duplex path configured to receive non-imaged print media from the media storage unit, it fails to teach the claimed logic to determine whether print media is inputted in the duplex media path as recited in claim 21. Thus, Stemmler fails to anticipate claim 21. Furthermore, Cala fails to cure this shortcoming of Stemmler and thus the combination fails to establish a prima facie obviousness rejection. Claim 21 should now be allowed.

Dependent Claims 9, 13 and 20

Claims 9, 13 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,042,791 (Stemmler) as applied to claims 6, 10 and 16 above, and further in view of U.S. Patent No. 6,308,948 (Azumi). Since Stemmler fails to teach or suggest the respective independent claims of claims 9, 13, and 20 as described above, the combined

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references fail to establish a prima facie obviousness rejection. The rejection should be withdrawn and these claims allowed.

Conclusion

For the reasons set forth above, claims 1-21 patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,



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